

REMARKS

Claims 1 and 11 are amended. The amendments were made to Claims 1 and 11 to improve clarity and follow the language of Claim 37, as further described in the following section. Accordingly, Claims 1-59 remain pending. Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections Under 35 U.S.C. §112, first paragraph

The Office rejected Claims 1 and 11 as not supported by the specification. The Applicant respectfully disagrees and believes that the Office has misinterpreted the Claims. However, to further expedite prosecution, the Applicant has amended Claims 1 and 11 to remove the double negative and follow the format of Claim 37, which was not rejected under §112, first paragraph. Accordingly, withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. §102

Claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 43, 49 and 52 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,963,925 to Kolling et al. (herein after Kolling). The Applicant respectfully disagrees.

Claim 1, as amended, recites in part "wherein the recipient can be either a user or a non-user of a secure email system, wherein the non-user has not registered for a service of the secure email system". In contrast, Kolling discloses in FIG. 8, block 708 "consumer requests electronic statement subscription for a biller". Thus, it appears that Kolling's system requires consumers to, in effect, register for a service. Therefore, the Applicant respectfully asserts that Kolling does not disclose the above recited feature of Claim 1.

1 The Office asserts the following portions of *Kolling* in rejecting the recited
2 feature of Claim 1:

3 It is important for a biller to deliver an invoice to a consumer
4 so that the consumer may then pay the bill presented in the
5 invoice. *Kolling, Col. 3, Lines 14-16.*

6 Although the present invention may operate stand-alone, in
7 one embodiment of the invention the electronic statement
8 presentment (ESP) system is an enhancement, or is
9 complimentary to any suitable electronic bill payment system.
10 In one specific embodiment, the ESP system is an
11 enhancement to the electronic bill payment system described
12 in U.S. Pat. No. 5,465,206, and in particular may be
13 integrated with VISA's ePay system to provide full-circle
14 electronic financial transactions for billers and consumers. By
15 introducing electronic statement presentment to an existing
16 electronic bill payment system, an added dimension enables
17 fully automated bill payment. *Kolling, Col. 4, Lines 30-41.*

18 A bank or other consumer service provider may also integrate
19 such an electronic statement delivery from a biller into its
20 own electronic home banking product in order to enhance that
21 product and to provide more value to its consumer. In this
22 fashion, a consumer may continue a relationship with his
23 current bank, yet still be able to receive electronic statements
24 from any biller from which the consumer receives a service.
25 Alternatively, a consumer may choose any consumer service
provider it desires that might provide electronic statements by
way of the present invention. Thus, the present invention
enhances the value of the consumer financial institution or
consumer service provider in the eyes of the consumer.
Kolling, Col. 5, Lines 17-29.

26 The consumer financial institution may then use any of a
27 variety of means to transmit this electronic statement to the
28 consumer. For example, any electronic home banking service
29 that the consumer financial institution supports may be used
30 to transmit the electronic statement to the consumer.
31 Electronic means such as the Internet, telephones, video
32 telephones, televisions, WebTV, personal digital assistants, or
33

any other proprietary communication system may be used.
 1 *Kolling, Col. 5, Lines 42-50.*

2 To begin enrollment, in step 704 the CSP advertises biller
 3 availability in providing electronic statements to consumers.
 4 This advertisement may take place in any of a variety of
 5 media that the CSP uses to communicate with its customers
 6 such as over the Internet, electronic mail, regular mail,
 7 telephone, newspaper advertisements, etc. *Kolling, Col. 26,*
 8 *Lines 25-30.*

9 As shown in the above excerpted portions, however, Kolling merely describes
 10 integrating "the electronic statement presentment (ESP) system" with an
 11 "electronic bill payment system". Neither the above excerpted portions of
 12 Kolling, nor elsewhere in the Kolling reference, is there disclosure for "wherein
 13 the recipient can be either a user or a non-user of a secure email system, wherein
 14 the non-user has not registered for a service of the secure email system" as recited
 15 in Claim 1. Rather, Kolling describes that each user is enrolled in the system. *See*
 16 *Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.*

17 Further, Claim 1 recites "wherein the amount of bill data included in the
 18 email message is based, at least in part, on an email address of a recipient". The
 19 Office asserts the following portions of Kolling in rejecting this recited feature,
 20 which are excerpted as follows:

21 A CFI associated with each SGEN delivers each electronic
 22 statement to the appropriate customer using a customer
 23 identifier in the statement data and uses any chosen medium.
 24 *Kolling, Abstract.*

25 Whereas billers currently use an invoicing system to print
 26 statements on paper for mailing, the present invention is able
 27 to retrieve electronic statement data from invoicing system
 28 204 for eventual generation of an electronic statement.
 29 Statement data 206 sent to biller 102 includes all of the data
 30 normally found in an invoice or a statement for a particular

1 consumer. In one specific embodiment, statement data 206 is
2 transmitted in the form of a statement augmented record
3 (SAR) when the data is sent from biller 102 to SORG 208 and
4 includes the identifier and version of the template that the
5 biller wishes to use in preparing an electronic statement for its
6 customers. Typically, a biller will send a batch or billing
7 round of statement data for numerous customers all at once,
8 although statement data 206 may be sent for a single
9 customer as well.

10 Template authoring workstation (TAWs) 210 is a computer
11 that may be physically located at, or operated by, the biller,
12 the BSP or the BFI. TAWs 210 utilizes current off-the-shelf
13 authoring software packages and software described herein to
14 create templates that contain the biller's processing
15 instructions for displaying statements and invoices. A
16 template contains the programmed instructions and graphic
17 pattern for statement information to be presented to the
18 consumer and is described in more detail below in FIG. 5.
19 *Kolling, Col. 9, Lines 34-55.*

20 Although the above excerpted portions describe "generation of an electronic
21 statement", Kolling does not disclose "the amount of bill data included in the
22 email message is based, at least in part, on an email address of a recipient" as
23 recited in Claim 1. Indeed, there is no mention whatsoever of a relationship
24 between an email address and an amount of bill data in Kolling. Rather, the
25 Office asserts that "Kolling adjusts the amount of information to fit the medium".
See *Office Action Dated January 27, 2005, Page 3.* It is respectfully submitted
that this is not the recited feature.

26 Accordingly, for at least these reasons it is respectfully submitted that a
27 *prima facie* case of anticipation has not been established with respect to Claim 1.
28 Consequently, withdrawal of the rejection with respect to Claim 1 is respectfully
29 requested.

1 **Claims 2, 8 and 10** depend either directly or indirectly from Claim 1 and
2 are allowable as depending from an allowable base claim. These claims are also
3 allowable for their own recited features which, in combination with those recited
4 in Claim 1, are neither shown nor suggested in the references of record, either
5 singly or in combination with one another.

6 **Claim 11**, as amended, recites in part “a financial transaction manager ...
7 to manage access to and manipulation of financial account assets to effect
8 requested financial transactions with any participant or non-participant, wherein
9 the non-participants have not registered for a service of an email system supported
10 by the email server”. The Office again asserts Kolling at Col. 33, Line 43 to Col.
11 44, Line 33 (essentially 11 columns of the reference) as disclosing an email server
12 having a storage medium and financial transaction manager. The Applicant
13 respectfully disagrees.

14 Again, the Applicant has not been able to determine which component(s) in
15 this very large amount of text correspond to an email server. As stated in the
16 MPEP, the Examiner “ordinarily should reject each claim on all valid grounds
17 available.” *M.P.E.P. §707.07(g)*. Further, “[w]here a major technical rejection is
18 proper, it should be stated with a full development of reasons rather than by a mere
19 conclusion coupled with some stereotyped expression.” *Id.* Accordingly, the
20 Applicant again respectfully requests a full development of the rejection.

21 Regardless, Kolling does not disclose, teach or suggest the above recited
22 feature of Claim 11. As previously described in relation to Claim 1, Kolling
23 merely describes integrating “the electronic statement presentment (ESP) system”
24 with an “electronic bill payment system”. Neither the above excerpted portions of
25 Kolling, nor elsewhere in the Kolling reference, is there disclosure for the recited

1 feature of Claim 11. Rather, Kolling describes that each user is enrolled in the
2 system. *See Kolling, FIG. 8 and accompanying discussion at Col. 27, Lines 37-55.*

3 Accordingly, for at least these reasons it is respectfully submitted that a
4 *prima facie* case of anticipation has not been established with respect to Claim 11.
5 Consequently, withdrawal of the rejection with respect to Claim 11 is respectfully
6 requested.

7 **Claims 12-19, 25, 28 and 36** depend either directly or indirectly from
8 Claim 11 and are allowable as depending from an allowable base claim. These
9 claims are also allowable for their own recited features which, in combination with
10 those recited in Claim 11, are neither shown nor suggested in the references of
11 record, either singly or in combination with one another.

12 **Claim 37** recites, in part, “a financial transaction manager ... to manage
13 access to and control assets of user accounts in response to user interaction with
14 the user interface to enable the user to conduct financial transactions with another
15 user or non-user of the email system, wherein the non-user of the email system has
16 not registered for a service of the email system”. The Office asserts the following
17 portion of Kolling in rejecting this feature:

18 Although the foregoing invention has been described in some
19 detail for purposes of clarity of understanding, it will be
20 apparent that certain changes and modifications may be
21 practiced within the scope of the appended claims. For
22 instance, the invention may be integrated with any suitable
23 electronic bill payment system. The functionality of the
24 coordinating entity, including the functionality of the TAWS,
25 the SORG, the switch, the SGEN, the TVAL, etc., may be
distributed throughout the ESP environment, and may be
implemented on separate computers or the functionality may
be combined on fewer computers. In particular, the
functionality of the SORG, the switch and the SGEN may be
implemented centrally on a single computer, or may be

1 implemented on separate computers. Furthermore, both the
2 SORG and SGEN may be located remotely at a biller and
3 CSP, respectively. Also, the central site switch may be
4 implemented using various computers performing different
5 aspects of the switch functionality. For example, one
6 computer may assist with ESP system functionality, while
7 another assists with an electronic bill payment system. In
8 addition, any format of data from a biller can be used, and the
9 invention is capable of producing statements in a variety of
10 data formats, including PDF, EDI 810, HTML, etc.
11 Furthermore, statements, invoices, account updates, bills, or
12 information of any kind may be transmitted using the present
13 invention from a biller to one of its customers. For
14 presentation of the information to a customer, any of a variety
15 of media may be used to transmit and display the information
16 from a CSP to the customer. Therefore, the described
17 embodiments should be taken as illustrative and not
18 restrictive, and the invention should not be limited to the
19 details given herein but should be defined by the following
20 claims and their full scope of equivalents. *Kolling, Col. 34,*
21 *Lines 35-67.*

22 As shown in the above excerpted portion, Kolling does not disclose, teach or
23 suggest a "user" or "non-user". Indeed, the asserted portion does not even include
24 the word "user". Rather, the asserted portion merely describes that the system of
25 Kolling may be implemented on separate computers and that statements may be
transmitted using a variety of media. Again, as previously stated in relation to
Claims 1 and 11, Kolling merely describes integrating "the electronic statement
presentment (ESP) system" with an "electronic bill payment system". Neither the
above excerpted portions of Kolling, nor elsewhere in the Kolling reference, is
there disclosure for the recited feature of Claim 37. Rather, Kolling describes that
each user is enrolled in the system. *See Kolling, FIG. 8 and accompanying*
discussion at Col. 27, Lines 37-55.

26 Accordingly, for at least these reasons it is respectfully submitted that a
27 *prima facie* case of anticipation has not been established with respect to Claim 37.

1 Consequently, withdrawal of the rejection with respect to Claim 37 is respectfully
2 requested.

3 **Claims 39, 40, 43, 49 and 52** depend either directly or indirectly from
4 Claim 37 and are allowable as depending from an allowable base claim. These
5 claims are also allowable for their own recited features which, in combination with
6 those recited in Claim 37, are neither shown nor suggested in the references of
7 record, either singly or in combination with one another.

8

9 **Rejections Under 35 U.S.C. §103**

10 Claims 3, 4-6, and 9 stand rejected under 35 U.S.C. §103(a) as unpatentable
11 over Kolling in view of Blossman. The Applicant respectfully disagrees.

12 As discussed above, the Applicant believes that Claim 1 is patentable over
13 Kolling. Blossman does not cure the defects of Kolling, namely with regard to non-
14 users as described above for Claim 1. Thus, the combination of Kolling and
15 Blossman does not teach every element of Claim 1 and, therefore does not make
16 out a *prima facie* case of obviousness. As claims 3, 4-6 and 9 depend from claim 1,
17 Applicants respectfully assert that these claims are patentable over the cited
18 references for at least the same reasons that claim 1 is patentable.

19 Further, with regard to **Claim 3**, the Office acknowledges that Kolling does
20 not disclose the feature, "wherein the email message includes an address of where
21 the bill data can be confidentially viewed if the recipient is not a participant in a
22 secure email network".

23 However, the Office then asserts Blossman (Col. 2, Lines 40-45) as
24 disclosing this feature. The Applicant respectfully submits that the asserted
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1 section of Bloassman does not teach or suggest "constructing the email message to
 2 include at least an address of where the bill data may be confidentially viewed if
 3 the recipient is a non-user of the secure email system" as recited in Claim 3. For
 4 convenience, the asserted portion of Blossman is reproduced below.

5 However, the full check image of the Simmons patent
 6 is not described as a pictorial image of the actual paper
 7 check and is illustrated as a printed line of text
 8 conveying the check number, date, amount, etc.
 9 Additionally, the Simmons patent discloses the use of
 10 electronic mail for the transmission of notifications
 11 regarding potential errors.

12 Although the above reproduced disclosure from Blossman does mention the use of
 13 electronic mail for notifications regarding errors, it does not disclose "an address
 14 of where the bill data can be confidentially viewed ..." as recited in Claim 3.

15 Therefore, the Applicant respectfully submits that the combination of
 16 Kolling and Blossman does not teach or suggest each and every element of Claim
 17 1, and consequently, does not make out a *prima facie* case of obviousness for this
 18 additional reason. As Claims 3, 4-6 and 9 depend from claim 1, the Applicant
 19 respectfully asserts that these claims are patentable over the cited references for at
 20 least this additional reason that claim 1 is patentable over the cited references.

21 Claims 26, 27, 38, 50, 51 and 59 stand rejected under 35 U.S.C. §103(a) as
 22 unpatentable over Kolling in view of U.S. Patent 6,629,081 (hereinafter Cornelius).
 23 The Applicant respectfully disagrees.

24 Claims 26 and 27 depend from claim 11, and claims 38, 50, 51 and 59
 25 depend from claim 37. As discussed above, claims 11 and 37 are distinguished
 26 from Kolling. Cornelius is cited as disclosing an electronic auction service, an
 27 electronic retail service, and an email system. However, such disclosures do not

1 overcome the deficiencies of Kolling with regard to Claims 11 and 37.
2 Accordingly, the combination of Kolling and Cornelius do not teach or suggest
3 each and every element of Claims 11 and 37 and, therefore, fail to make out a
4 *prima facie* case of obviousness for claims 11 and 37. As each of Claims 26, 27,
5 38, 50, 51 and 59 depend from Claim 11 or 37, these dependent claims are
6 patentable over the cited references for at least the reasons that Claims 11 and 37
7 are patentable over the cited references.

8 **Claims 29, 31, 53 and 55** stand rejected under 35 U.S.C. §103(a) as
9 unpatentable over Kolling in view of U.S. Patent 6,678,664 (hereinafter Ganesan).
10 The Applicant respectfully disagrees.

11 Claims 29 and 31 depend from claim 11, and claims 53 and 55 depend from
12 claim 37. As discussed above, Claims 11 and 37 are distinguished from Kolling.
13 Ganesan is cited as disclosing “wherein the financial transaction manager
14 determines whether to honor the participant’s payment when the specified account
15 has insufficient assets to cover the requested payment.” Ganesan is also cited as
16 disclosing “honoring a check if adequate prior credit arrangements are made.”
17 Ganesan is also cited as disclosing “wherein the financial transaction manager
18 automatically accesses a line of credit associated with the participant to honor the
19 payment when the specified account has insufficient assets to cover the requested
20 payment.”

21 However, such disclosures do not overcome the deficiencies of Kolling
22 with regards to Claims 11 and 37. Accordingly, the combination of Kolling and
23 Ganesan do not teach or suggest each and every element of Claims 11 and 37 and,
24 therefore, fail to make out a *prima facie* case of obviousness for these independent
25 claims. As each of Claims 29, 31, 53, and 55 depend from Claim 11 or 37, these

1 dependent claims are patentable over the cited references for at least the reasons
2 that Claims 11 and 37 are patentable over the cited references.

3 **Claim 32** stands rejected under 35 U.S.C. §103(a) as unpatentable over
4 Kolling in view Ganesan and further in view of Blossman. The Applicant
5 respectfully disagrees.

6 **Claim 32** depends from **Claim 11**. As discussed above, **Claim 11** is
7 patentable over the combination of Kolling and Ganesan. Blossman is cited as
8 disclosing, “wherein the financial transaction manager notifies the participant of
9 the insufficient funds and that the line of credit has been accessed to honor the
10 requested payment.”

11 However, such a disclosure does not overcome the deficiencies of Kolling
12 and Ganesan with regards to **Claim 11**. Accordingly, the combination of Kolling,
13 Ganesan and Blossman do not teach or suggest each and every element of **Claim**
14 **11** and, therefore, fails to make out a *prima facie* case of obviousness for **Claim**
15 **11**. As **Claim 32** depends from **Claim 11**, **Claim 32** is patentable over the cited
16 references for at least the reasons that **Claim 11** is patentable over the cited
17 references.

18 **Claim 30** stands rejected under 35 U.S.C. §103(a) as unpatentable over
19 Kolling in view Ganesan and further in view of U.S. Patent 5,649,116 (hereinafter
20 McCoy). The Applicant respectfully disagrees.

21 **Claim 30** depends from **claim 11**. As discussed above, **Claim 11** is
22 patentable over the combination of Kolling and Ganesan. McCoy is cited as
23 disclosing, “wherein the financial transaction manager utilizes a growing model to
24 determine whether to honor the payment when the specified account has
25 insufficient assets to cover the requested payment.”

1 However, such a disclosure does not overcome the deficiencies of Kolling
 2 and Ganesan in regards to Claim 11. Accordingly, the combination of Kolling,
 3 Ganesan and McCoy do not teach or suggest each and every element of Claim 11
 4 and, therefore, fails to make out a *prima facie* case of obviousness for Claim 11.
 5 As Claim 30 depends from Claim 11, Claim 30 is patentable over the cited
 6 references for at least the reasons that Claim 11 is patentable over the cited
 7 references.

8 **Claim 54** stands rejected under 35 U.S.C. §103(a) as unpatentable over
 9 Kolling in view McCoy. The Applicant respectfully traverses the rejection.

10 Claim 54 depends from Claim 37. As discussed above, Claim 37 is
 11 patentable over Kolling. McCoy is cited as disclosing, "wherein the financial
 12 transaction manager utilizes a growing model to determine whether to honor the
 13 payment when the specified account has insufficient assets to cover the requested
 14 payment."

15 However, such a disclosure does not overcome the deficiencies of Kolling
 16 with regards to Claim 37. Accordingly, the combination of Kolling and McCoy
 17 do not teach or suggest each and every element of Claim 37 and, therefore, fails to
 18 make out a *prima facie* case of obviousness for Claim 37. As Claim 54 depends
 19 from Claim 37, Claim 54 is patentable over the cited references for at least the
 20 reasons that Claim 37 is patentable over the cited references.

21 **Claims 22, 23, 46 and 47** stand rejected under 35 U.S.C. §103(a) as
 22 unpatentable over Kolling in view of U.S. Patent 6,049,784 (hereinafter Weatherly).
 23 The Applicant respectfully disagrees.

24 Claims 22 and 23 depend from claim 11, and claims 46 and 47 depend from
 25 claim 37. As discussed above, claims 11 and 37 are distinguished from Kolling.

1 Weatherly is cited as disclosing "wherein the financial transaction manager
2 selectively receives assets for deposit in an account of a participant." Weatherly is
3 also cited as disclosing "wherein the assets are received from a brokerage at the
4 request of the participant."

5 However, such disclosures do not overcome the deficiencies of Kolling in
6 regards to Claims 11 and 37. Accordingly, the combination of Kolling and
7 Weatherly do not teach or suggest each and every element of Claims 11 and 37
8 and, therefore, fail to make out a *prima facie* case of obviousness for these
9 independent claims. As each of Claims 22, 23, 46 and 47 depend from Claim 11
10 or 37, these dependent claims are patentable over the cited references for at least
11 the reasons that Claims 11 and 37 are patentable over the cited references.

12 **Claim 7** stands rejected under 35 U.S.C. §103(a) as unpatentable over
13 Kolling in view Blossman and further in view of Cornelius. The Applicant
14 respectfully disagrees

15 Claim 7 depends from Claim 1. As discussed above, Claim 1 is patentable
16 over the combination of Kolling and Blossman. Cornelius is cited as disclosing,
17 "identifying a domain name from the email address; and cross referencing the
18 identified domain name against a list of secure domain names to determine
19 whether the recipient belongs to a secure email network."

20 Applicants respectfully assert that the cited portion of Cornelius does not
21 teach or suggest identifying a domain name from an email address. Rather, the
22 cited portion of Cornelius appears to be directed to the firewalls shown in
23 FIGS. 37 and 38. As can be seen in FIGS. 37 and 38, the firewalls are directed to
24 protecting web servers and not email servers.

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1 Further, the cited portion of Cornelius does not mention email address;
2 instead it lists "user names and passwords, Internet IP address or domain name."
3 There is no indication of where the domain is obtained. Moreover, the disclosure
4 of web servers in FIGS. 37 and 38 would indicate that the domain name is
5 obtained from web address and not an email address. Therefore, the listing of
6 multiple security techniques does not teach or suggest identifying a domain name
7 from an email address.

8 However, assuming *for the sake of argument alone* that Cornelius does
9 disclose identifying a domain name from an email address, such a disclosure does
10 not overcome the deficiencies of Kolling and Blossman in rendering Claim 1
11 obvious. Accordingly, the combination of Kolling, Blossman and Cornelius does
12 not teach or suggest each and every element of Claim 1 and, therefore, fails to
13 make out a *prima facie* case of obviousness for claim 1. As Claim 7 depends from
14 Claim 1, Claim 7 is patentable over the cited references for at least the reasons that
15 Claim 1 is patentable over the cited references.

16 **Claims 24 and 48 stand rejected under 35 U.S.C. §103(a) as unpatentable**
17 **over Kolling in view Weatherly and further in view of U.S. Patent 6,401,079**
18 **(hereinafter Kahn).** The Applicant respectfully disagrees.

19 Claim 24 depends from Claim 11, and Claim 48 depends from Claim 37.
20 As discussed above, Claims 11 and 37 are distinguished from Kolling combined
21 with Weatherly. Kahn is cited as disclosing "wherein the assets are received from
22 an employer as compensation to the participant."

23 However, such a disclosure does not overcome the deficiencies of Kolling
24 combined with Weatherly with regard to Claims 11 and 37. Accordingly, the
25 combination of Kolling, Weatherly and Kahn does not teach or suggest each and

1 every element of Claims 11 and 37 and, therefore, fails to make out a *prima facie*
2 case of obviousness for these independent claims. As Claims 24 and 48
3 respectively depend from Claims 11 and 37, these dependent claims are patentable
4 over the cited references for at least the reasons that Claims 11 and 37 are
5 patentable over the cited references.

6 **Claims 20, 21, 44 and 45** stand rejected under 35 U.S.C. §103(a) as
7 unpatentable over Kolling in view of U.S. Patent 5,983,200 (hereinafter Slotznick).
8 The Applicant respectfully disagrees.

9 Claims 20 and 21 depend from Claim 11, and Claims 44 and 45 depend
10 from Claim 37. As discussed above, Claims 11 and 37 are distinguished from
11 Kolling. Slotznick is cited as disclosing “wherein the first participant does not
12 have a prior knowledge of the second participant’s account information, but
13 identifies the second participant from a list of network participants, wherein the
14 second participant is identified by one of a name, an alias, or an email address.”

15 However, such disclosures do not overcome the deficiencies of Kolling in
16 anticipating Claims 11 and 37. Accordingly, the combination of Kolling and
17 Slotznick does not teach or suggest each and every element of Claims 11 and 37
18 and, therefore, fails to make out a *prima facie* case of obviousness for these
19 independent claims. As each of Claims 20, 21, 44 and 45 depend from Claim 11
20 or 37, these dependent claims are patentable over the cited references for at least
21 the reasons that Claims 11 and 37 are patentable over the cited references.

22 **Claims 33, 41 and 46** stand rejected under 35 U.S.C. §103(a) as
23 unpatentable over Kolling in view of Kahn. Applicants respectfully traverse.

24 Claim 33 depends from Claim 11, and Claims 41 and 46 depend from
25 Claim 37. As discussed above, Claims 11 and 37 are distinguished from Kolling.

1 Kahn is cited as disclosing "wherein the financial transaction manager issues an
2 instruction to have a check issued and sent to an address specified by the request,
3 upon authorization of the participant where the participants are an employer, a
4 payment service, the employer's bank, and the employee payee who can receive a
5 paper check instead of an electronic payment which is authorized by the employer
6 payer."

7 However, such disclosures do not overcome the deficiencies of Kolling in
8 anticipating Claims 11 and 37. Accordingly, the combination of Kolling and Kahn
9 does not teach or suggest each and every element of Claims 11 and 37 and,
10 therefore, fails to make out a *prima facie* case of obviousness for these
11 independent claims. As each of Claims 33, 41 and 46 depend from Claim 11 or
12 37, these dependent claims are patentable over the cited references for at least the
13 reasons that Claims 11 and 37 are patentable over the cited references.

14 **Claims 34 and 57 stand rejected under 35 U.S.C. §103(a) as unpatentable**
15 over Kolling in view of Kahn and further in view of "Wells Fargo Online". The
16 Applicant respectfully traverses the rejection.

17 Claim 34 depends from Claim 11, and Claim 57 depends from Claim 37.
18 As discussed above, Claims 11 and 37 are distinguished from Kolling combined
19 with Kahn. Wells Fargo Online is cited as disclosing "the inclusion of a URL
20 where the recipient can establish an account."

21 However, such disclosures do not overcome the deficiencies of Kolling and
22 Kahn with regard to Claims 11 and 37. Accordingly, the combination of Kolling,
23 Kahn and Wells Fargo Online does not teach or suggest each and every element of
24 Claims 11 and 37 and, therefore, fails to make out a *prima facie* case of
25 obviousness for these independent claims. As Claims 34 and 57 respectively

1 depend from Claim 11 or 37, these dependent claims are patentable over the cited
2 references for at least the reasons that Claims 11 and 37 are patentable over the
3 cited references.

4 **Claims 35, 42 and 58 stand rejected under 35 U.S.C. §103(a) as**
5 **unpatentable over Kolling in view of Kahn and further in view of U.S. Patent No.**
6 **6,442,529 (hereinafter Krishan). Applicants respectfully traverse.**

7 **Claim 35 depends from Claim 11, and Claims 42 and 58 depend from**
8 **Claim 37. As discussed above, Claims 11 and 37 are patentable over Kolling**
9 **combined with Kahn. Krishan is cited as disclosing "offering a free service**
10 **product as an incentive for a prospect to try a service."**

11 However, such a disclosure does not overcome the deficiencies of Kolling
12 combined with Kahn in with regard Claims 11 and 37. Accordingly, the
13 combination of Kolling, Kahn and Krishan does not teach or suggest each and
14 every element of Claims 11 and 37 and, therefore, fails to make out a *prima facie*
15 case of obviousness for these independent claims. As each of Claims 35, 42 and
16 58 depend from Claim 11 or 37, these dependent claims are patentable over the
17 cited references for at least the reasons that Claims 11 and 37 are patentable over
18 the cited references.

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CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe all pending claims are allowable. Accordingly, a Notice of Allowability is respectfully requested.

Respectfully Submitted,

Dated: 4/8/5

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